

REMARKS

In the August 8, 2006, Office Action (the "Office Action"), the Examiner rejected claims 1-6, 8, 9, 11, 12, 14, 15, 17-25, 27, 29, 30, 32, 33 and 35-37 under 35 USC §103(a) as being unpatentable over the horizontal accumulator (referred to herein as the "Horizontal Accumulator") described in the Supplemental Information Disclosure Statement filed on July 25, 2006, in view of Fisher USP 5,490,587, and rejected claims 7, 10, 13, 16, 26, 28, 31 and 34 under 35 USC §103(a) as being unpatentable over the Horizontal Accumulator in view of Fisher USP 5,490,587 and further in view of Maxted USP 4,039,074. Applicants have amended the claims to more particularly point out the invention, and assert that the claims are in order for allowance.

In rejecting the claims, the Examiner has combined the Horizontal Accumulator, a horizontal conveyor with two powered zones, with Fisher, a downwardly inclined non-powered conveyor. More specifically, the Examiner asserted that every feature of independent claims 1, 14, 20 and 32 are found in the Horizontal Accumulator except for the declination of the conveyor, which the Examiner asserts can be found in Fisher. The Examiner further asserted that each and every feature added by dependent claims 2-6, 8, 9, 11, 12, 15, 17-19, 21-25, 27, 28, 30, 33 and 35-37 are found in the Horizontal Accumulator. In rejecting claims 7, 10, 13, 16, 26, 28, 31 and 34, the Examiner asserted that the Horizontal Accumulator, as modified by Fisher, contains all of the features of these claims, except for the skewed rollers, which the Examiner asserts are found in Maxted USP 4,039,074.

Applicants have amended the claims to clarify the features thereof. Applicants request that the examiner reconsider the rejections and allow the claims in their current form.

The Horizontal Accumulator in view of Fisher

Claims 1, 14, 20 and 32 have been amended to incorporate the feature recited in claims 8, 19, 17 and 37, respectively. In particular, claims 1, 14, 20 and 32 recite that the drive member generally extends in the longitudinal direction.

The Examiner's suggestion of modifying the Horizontal Accumulator powered conveyor by incorporating the incline found in Fisher is not a proper absent this specific prior art containing some motivation to combine the references. MPEP § 2143 (Basic Requirements of a

Prime Facie Case of Obviousness). This is true even if the modification to the prior art necessary to obtain the claimed invention would have been “well within the ordinary skill in the art at the time the claimed invention was made.” MPEP § 2143.01(IV) (Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is not Sufficient By Itself to Establish *Prima Facie* Obviousness). Further, Applicants note that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” MPEP § 2142 (Legal Concept of *Prima Facie* Obviousness) (emphasis added).

Turning now to the rejection of claims 1, 14, 20 and 32, Applicants note that no motivation to modify the Horizontal Accumulator by Fisher was identified. The Office Action asserted that “[t]o incline the prior art [Horizontal Accumulator] would have been obvious and well within the skill of the art as the conveyor would still function in its intended manner while the incline might reduce the drive forces needed to move articles”. Office Action at 2. However, even assuming, *arguendo*, that the proposed modification of the Horizontal Accumulator by Fisher results in all of the features of the rejected claims, for the rejection of claims 1, 14, 20 and 32 to have been proper, it is still necessary to show some objective reason from this prior art itself to make such a modification. The Manual of Patent Examining Procedure specifically addresses the situation where each limitation of an invention is taught in the prior art, and states that the existence of each limitation in the prior art is not sufficient to establish a *prima facie* case of obviousness. *See* MPEP § 2143.01(IV) (“A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.”) (emphasis in original). Accordingly, because a *prima facie* case of obviousness for claims 1, 14, 20 and 32 has not been made out, Applicants request that the rejection of that claim be withdrawn, and that the claims be allowed.

Furthermore, the combination of the Horizontal Accumulator and Fisher lacks at least one feature found in claims 1, 14, 20 and 32. As indicated in the description of the Horizontal

Accumulator submitted with the Supplemental Information Disclosure Statement filed on July 25, 2006, zone 1 and zone 2 each have powered rollers that are driven by motor driven rollers. The description states “[t]he MDRs are part of the conveying surface”. As would be understood by a person of ordinary skill in the art, in order to be part of the conveying surface, the MDRs are transverse to the longitudinal direction of the conveyor. In the Horizontal Accumulator, the MDRs are parallel to the non-powered rollers, with the ends of MDRs being supported by the conveyor frame rails.

Claims 1, 14, 20 and 32 require that each drive member’s drive axis of rotation generally extend in the longitudinal direction. In the proposed combination, the drive members’ respective drive axes of rotation are perpendicular to the longitudinal direction, lying parallel to the conveying rollers.

Thus, the proposed modification of the Horizontal Accumulator by Fisher does not render obvious claims 1, 14, 20 and 32 obvious, nor any claims dependent therefrom. Applicants request that the Examiner withdraw the rejection of the claims.

The Horizontal Accumulator in view of Fisher and Maxted

For the reasons stated above, the Examiner’s suggestion of modifying the Horizontal Accumulator powered conveyor by incorporating the incline found in Fisher and by incorporating the skewed rollers of Maxted is not proper absence this specific prior art containing some motivation to combine the references. Thus, the modification proposed by the Examiner cannot be made.

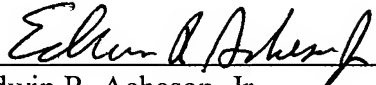
Additionally, as discussed above, the proposed modifications lack the features found in claims 7, 10, 16, 26, 28 and 34. (Claim 13 has been amended and no longer recites skewed rollers. Claim 31 has been cancelled). These claims add the skewed roller feature to the features recited in the claims from which they depend. However, as discussed above, the modification of the Horizontal Accumulator with the incline of Fisher does not result in a construction that renders obvious the parent claims of claims 7, 10, 16, 26, 28 and 34 depend.

In light of the remarks made herein, it is respectfully submitted that the claims currently pending in the present application are in form for allowance. Accordingly, reconsideration of those claims, as amended herein, is earnestly solicited. The Applicant encourages the Examiner to contact the undersigned at (513)651-6708 or eacheson@fbtlaw.com.

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Respectfully submitted,

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